

## **REMARKS/ARGUMENTS**

The Office Action of May 18, 2006 has been carefully reviewed and this response addresses the Examiner's concerns stated in the Office Action. All objections and rejections are respectfully traversed.

### **I. STATUS OF THE CLAIMS**

Claims 1-6 are pending in the application.

Claims 1-6 were rejected under 35 U.S.C. §102(b) as being anticipated by Stone et al. (U.S. 5,786,124).

Claims 7-17 have been canceled without prejudice.

### **II. CLAIM REJECTIONS UNDER 35 USC § 102(b)**

*Claims 1-9, 11, 13, 14 and 16 were rejected under 35 U.S.C. §102(b) as being anticipated by Stone et al. (U.S. 5,786,124, the '124 patent).*

Claim 1 recites a method for introducing selectable amounts of temporal dispersion into a signal. The '124 patent does not teach temporal dispersion compensation. The '128 patent teaches, in col. 2, lines 34-43, that "Each wavelength exhibits a like amount of phase lag," that "the phase lag is independent of wavelength " and that "the broad spectrum of wavelengths are phase shifted by like amounts corresponding to the displacement of the grating." The '124 patent does not teach introducing selectable amounts of temporal dispersion.

The '124 patent does not teach or show "angularly separating spectral components of the electromagnetic radiation beam, by the steps of selectively directing and subsequently selectively directing the electromagnetic radiation beam-in order to introduce the selectable amounts of temporal dispersion," a limitation of claim 1. Therefore, there is no showing or teaching of how the system of the '124 patent is used to introduce the selectable amounts of temporal dispersion and Applicant asserts that reliance on inherency for anticipation is not proper.

Also, as recently stated by the Court of Appeals for the Federal Circuit in *Perricone vs. Medicis Pharmaceutical Corp*, 432 F. 3d 1368, 1379 (Fed. Cir. 2005), a patent for a system or apparatus does not prevent a subsequent inventor from obtaining a patent on a new method for using the system or apparatus. As in *Perricone*, where the anticipating reference did not teach treatment of skin sunburn, the '124 patent does not teach introducing the selectable amounts of temporal dispersion. Since the '124 patent does not teach or disclose introducing the selectable amounts of temporal dispersion, principles of inherency do not preclude a method invention for the new use, introducing the selectable amounts of temporal dispersion.

Claim 2 recites the additional limitation of repeating step b) until a direction of propagation of the electromagnetic radiation beam is substantially parallel to an input direction. The Examiner, in the Office Action, stated that figure 1 of the '124 patent shows an output beam substantially parallel to an input direction. In describing figure 13, the '124 patent states, in col.4, lines 15-18, that figure 1 shows a "vertex grating 14[that] then diffracts this dispersed light back toward the second base grating 12 where the spectral components are spatially recombined and form the output." The '124 patent does not teach that the output beam substantially parallel to an input direction. "Inherency, however, may not be established by probabilities or possibilities." MPEP 2112

Claim 4 recites a method for compensating angular dispersion including the limitation of rendering, after selective diffraction, a direction of propagation of the electromagnetic radiation output beam parallel to an input direction. The '124 patent does not teach angular dispersion compensation. The '124 patent is silent as to angular dispersion compensation. The Examiner, in the Office Action, stated that figure 1 of the '124 patent shows an output beam substantially parallel to an input direction. However, the '124 patent does not teach that the output beam substantially parallel to an input direction.

As stated above, a patent for a system or apparatus does not prevent a subsequent inventor from obtaining a patent on a new method for using the system or apparatus. Since the '124 patent does not teach or disclose angular dispersion compensation, principles of inherency do not preclude a method invention for the new use, angular dispersion compensation.

Claim 6 recites selectively diffracting at least one crosstalk induced output electromagnetic radiation beam. The '124 patent is silent in regards to crosstalk induced output electromagnetic radiation beams; the '124 patent does not teach diffracting at least one crosstalk induced output electromagnetic radiation beam. The Examiner equates the beams, red and blue, passing through 14 that are diffracted again by grating 12 in Fig. 1 of the '124 patent. But there is no indication that the beams, red and blue, are crosstalk induced. In fact, the '124 patent states, in col. 4, lines 10-15, that "longer wavelengths (denoted symbolically as "red") are diffracted through larger angles than the shorter (blue) wavelengths." Crosstalk is never considered by the '124 patent.

Applicant respectfully asserts that claim 1 and claim 4 are not inherently or explicitly anticipated by the '124 patent. Since claims 2 and 3 are dependent on claim 1 and claims 5 and 6 are dependent on claim 4, Applicant respectfully asserts that claims 1-6 are not inherently or explicitly anticipated by the '124 patent.

#### IV. CONCLUSION

In conclusion, in view of the above remarks, Applicant respectfully asserts that claims 1-6 in this application are now in condition for allowance and respectfully request the Examiner find claims 1-6 allowable over the prior art and pass this case to issue.


The Director of Patents and Trademarks is hereby authorized to charge the fees for the Request for Continued Examination and the Petition for Extension of Time, and any additional fees, or to credit overpayment, to Deposit Account No. 50-3718.

The following information is presented in the event that a call may be deemed desirable by the Examiner:

JACOB ERLICH (617) 345-3000.

Respectfully submitted,  
Thomas W. Stone, Applicant,

Date: September 14, 2006

By:   
Jacob N. Erlich  
Reg. No. 24,338  
Attorney for Applicants

01054690

**Amendments to the Drawings:**

The attached four (4) sheets of drawings include changes to the figures to replace the label Figures 1(a), 1(b) and 2 as prior art from Hand Script to printed . Two of the sheets are replacement sheets, and two are annotated sheets showing changes to the drawings in red ink.

ANNOTATED SHEET

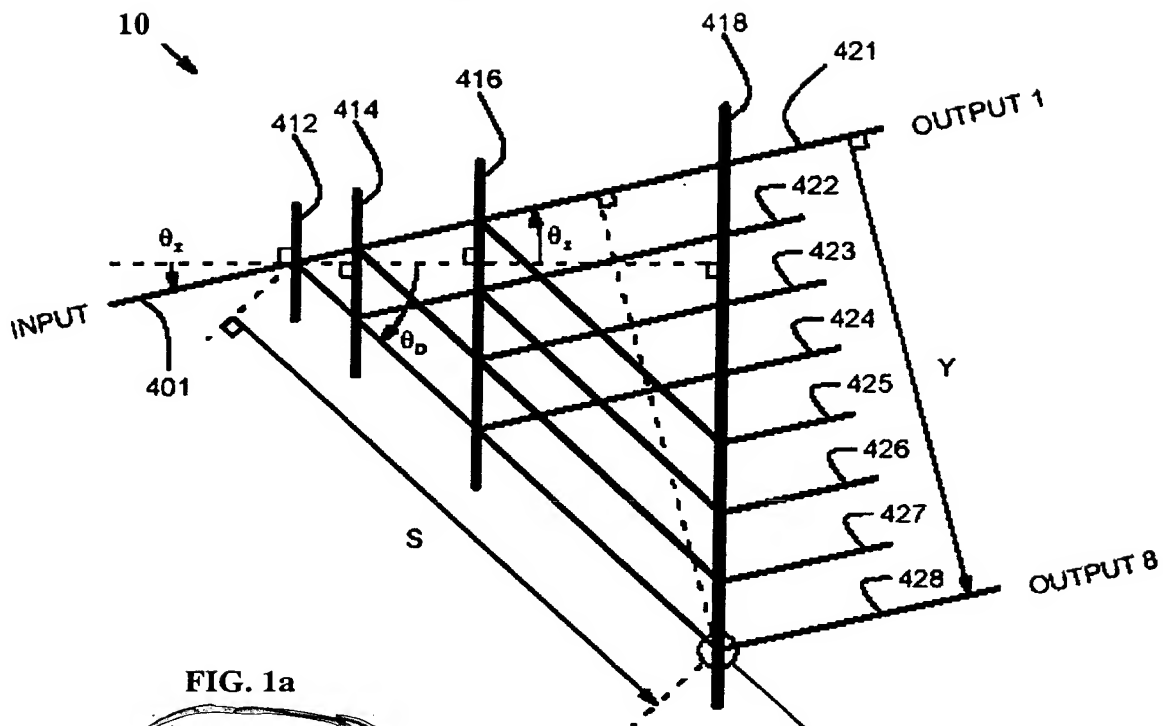


FIG. 1a

PRIOR ART

SEE  
EXPANDED  
VIEW

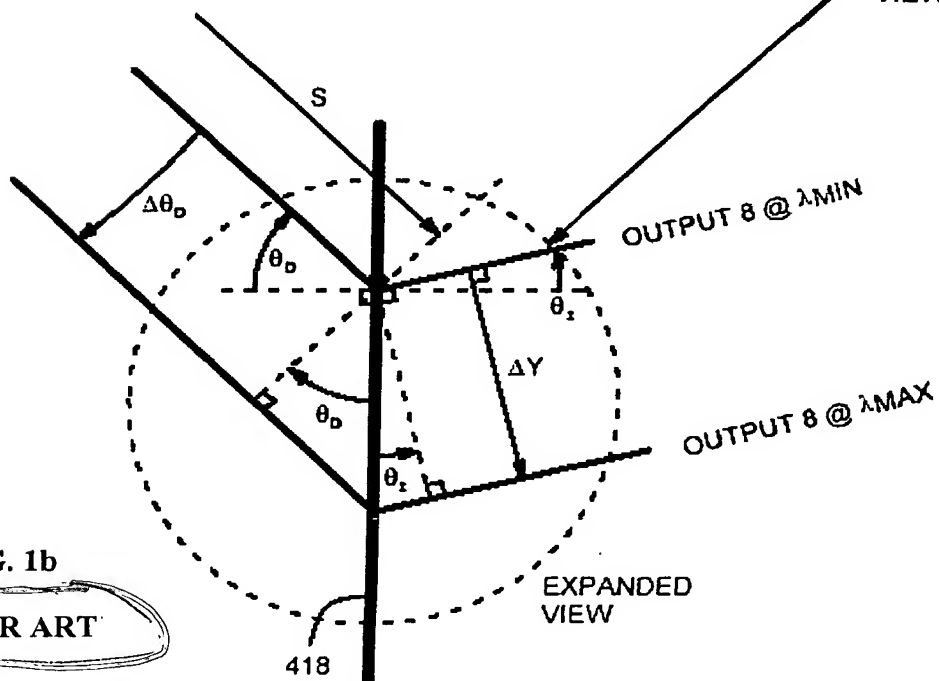


FIG. 1b

PRIOR ART

EXPANDED  
VIEW

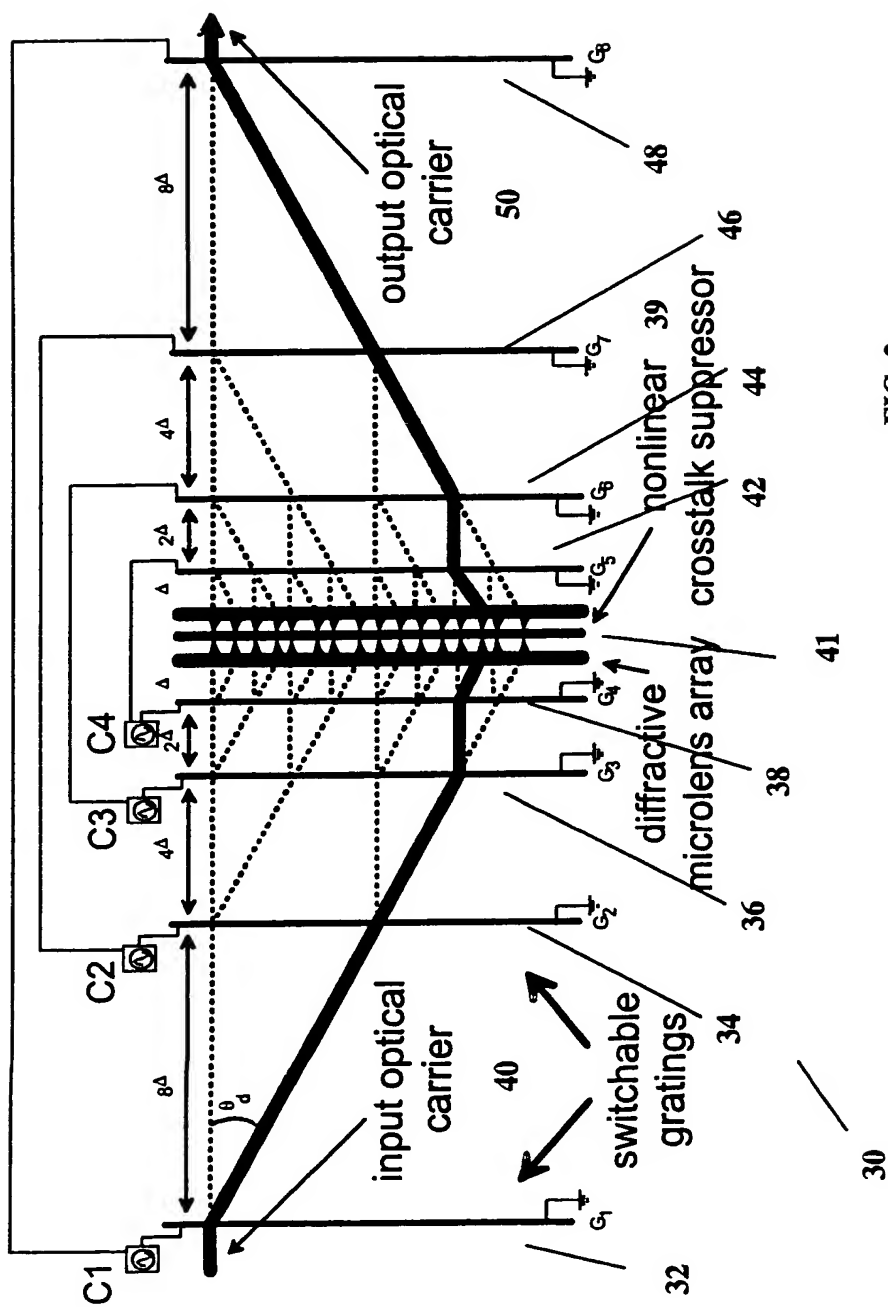


FIG. 2

PRIOR ART